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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,663

02/03/2005

Keiji Otaki

122381

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25944 7590 04/12/2007
OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

O HERN, BRENT T

ART UNIT

PAPER NUMBER

1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/520,663

Applicant(s)

OTAKI ET AL.

Examiner

Brent T. O'Hern

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10 Jan 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims

1. Claims 1-7 and 9-16 are pending.

WITHDRAWN OBJECTIONS

2. The objections to the Drawings of record in the Office Action mailed 22 September 2006, page 2, paragraph 3, are withdrawn due to Applicant's amendments in the Paper filed 22 February 2007.

WITHDRAWN REJECTIONS

3. The 35 USC 112 rejections of claims 1-7 and 9-16, of record in the Office Action mailed 22 September 2006, page 4, paragraph 4, are withdrawn due to Applicant's amendments in the Paper filed 22 February 2007.
4. The 35 USC 102(b) rejections of claims 1-6 and 9-11 as being anticipated by Cameron et al. (US 4,552,793), of record in the Office Action mailed 22 September 2006, page 5, paragraph 5, are withdrawn due to Applicant's amendments in the Paper filed 22 February 2007.
5. The 35 USC 103(a) rejections of claims 7 and 12-16 as being unpatentable over Cameron et al. (US 4,552,793) in view of Berdan, II (US 5,350,063), of record in the Office Action mailed 22 September 2006, page 7, paragraph 6, are withdrawn due to Applicant's amendments in the Paper filed 22 February 2007.

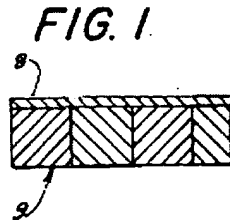
NEW REJECTIONS

Claim Rejections - 35 USC § 102

6. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Botsolas (US 4,054,710).

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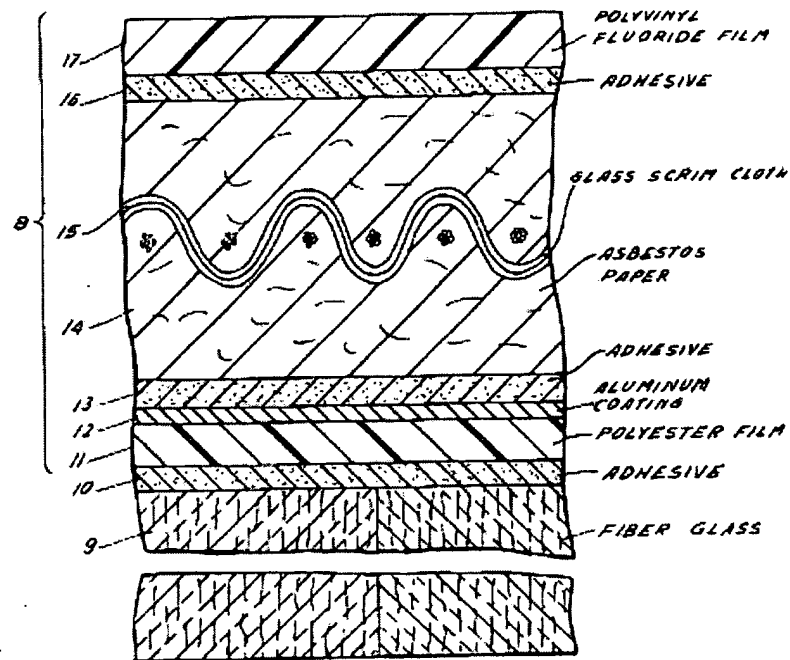
Regarding claim 1, Botsolas ('710) teaches a mat-shaped thermal insulator made of inorganic fiber (*col. 3, ll. 8-15 and FIG-1*), wherein at least a part of inorganic fibers is built-up in a direction parallel to lateral surfaces of the insulator (*col. 3, ll. 26-55*), and the insulator has a density of about $10\text{-}32\text{ kg/m}^3$ / ($0.62\text{-}1.99\text{ lb/ft}^3$) (*col. 3, ll. 16-20*).



The phrase **“said insulator is formed by cutting a fibrous built-up article formed by building-up inorganic fibers, to form cut built-up articles, rotating at least one of the cut articles by an angle of 90 degrees in a direction perpendicular to a longitudinal direction, to form a rotated built-up article in which the inorganic fibers are built-up in a direction parallel to lateral sides of the cut article, and integrating the cut articles and/or the rotated article transversally in a direction perpendicular to the longitudinal direction”** in claim 1, lines 6-13 are **process limitations** in a product claim and hence not given any patentable weight since patentability of a product does not depend on its method of production (see MPEP 2173.05(p)).

Regarding claim 2, Botsolas ('710) teaches an insulator wherein the lateral surfaces of the insulator are inclined (*col. 3, ll. 44-55 and FIG-2, sides*).

Regarding claims 3 and 9, Botsolas ('710) teaches an insulator wherein the insulator is provided with longitudinal cuts on the lateral surfaces of the insulator (*col. 3, ll. 18-24 and FIG-1, vertical cuts*).

**FIG. 2**

The phrase “so as to make the insulator partially compressible” in claims 3 and 9, line 3 of both claims is not given any patentable weight since the applicant is introducing **use** limitations into the product claims (see *MPEP* 2173 (q)).

Regarding claims 4, 10 and 11, Cameron Botsolas ('710) teaches an insulator wherein at least one of the surfaces of the insulator is coated by a facing material (*FIG-1*, #8 and col. 2, ll. 40-48).

Regarding claims 5-6, Botsolas ('710) teaches an insulator wherein the insulator and the facing material are bonded to each other by means of an adhesive agent (*FIG-2*, #10).

Claim Rejections - 35 USC § 103

7. Claims 7 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botsolas (US 4,054,710) in view of Berdan, II (US 5,350,063).

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Botsolas ('710) teaches wherein each of the mat-shaped inorganic fiber thermal insulators, inorganic fibers are built-up in a direction of a width of the aligned article (*FIG-1, width of #9*), however, fails to expressly disclose a package and wherein the package comprises a packaging bag.

However, Berdan, ('063) teaches a package and wherein the package comprises a packaging bag (*col. 1, ll. 18-20 and FIG-8*) for the purpose of reducing transportation costs (*col. 1, ll. 14-18*).

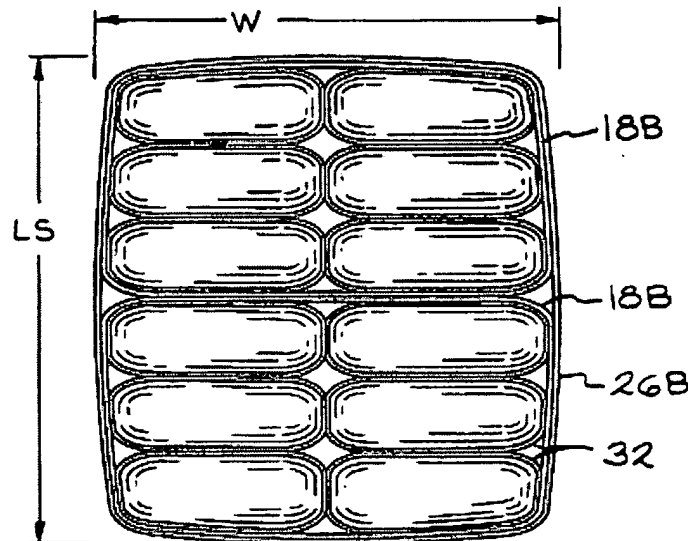


FIG. 8

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicants' invention was made to modify Botsolas' ('710) insulator with a packaging bag as taught by Berdan, ('063) in order to provide a packaged article with reduced transportation costs.

The phrases "**said aligned articles are compressed transversally, said aligned articles are formed by arranging a plurality of mat-shaped inorganic fiber thermal insulators according to claim ... in parallel and/or by laying the insulators**

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one on the other” in claims 7 and 12-16, lines 4-8 of all claims are **process limitations** in a product claims and hence not given any patentable weight since patentability of a product does not depend on its method of production (see MPEP 2173.05(p)).

ANSWERS TO APPLICANT'S ARGUMENTS

8. In response to Applicant's argument (*p. 11, paras. 1-2 of Applicant's Paper filed 22 February 2007*) that Cameron ('793) does not teach the density of amended independent claim #1, it is noted that the rejection based on Cameron ('793) has been withdrawn, thus Applicant's arguments are moot.

9. In response to Applicant's argument (*p. 11, para. 3 to p. 12, para. 1 of Applicant's Paper filed 22 February 2007*) that Cameron ('793) does not teach the limitations of claims 2, 3 and 9, it is noted that the rejection based on Cameron ('793) has been withdrawn, thus Applicant's arguments are moot.

10. In response to Applicant's statement (*p. 12, paras. 3-6 of Applicant's Paper filed 22 February 2007*) that Berdan, II (US 5,350,063) does not overcome the deficiencies of Cameron ('793), it is noted that Applicant has not provided any analysis to support said conclusion.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

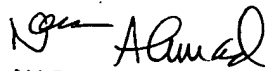
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-2172. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BTH

Brent T O'Hern
Examiner
Art Unit 1772
March 23, 2007


NASSER AHMAD
PRIMARY EXAMINER 4/9/07